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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,493	10/24/2000	Christian Volf Olgaard	68139769-200100	2756
23418	7590	12/01/2005	EXAMINER	
VEDDER PRICE KAUFMAN & KAMMHOLZ 222 N. LASALLE STREET CHICAGO, IL 60601			EL CHANTI, HUSSEIN A	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/695,493

Applicant(s)

OLGAARD ET AL.

Examiner

Hussein A. El-chanti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date #10/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to RCE received on Oct. 17, 2005. Claims 1-4, 7-11, 13-16, 18-29 and 31-35 were amended. Claims 1-36 are pending examination.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 13 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 1, 13 and 25 do not specify the device performing the steps of "selecting interface clients", "notifying the wireless device", "initiating a connection with the client", "executing an application" and "transmitting an application". It is unclear whether the above recited steps are performed by the client device or the infrastructure server.
4. Claims 2, 14 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 2, 14 and 26 recite the limitation "it" in the claim. There is insufficient antecedent basis for this limitation in the claim.
6. Claims 13 – 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 13 – 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

8. Claims 13 – 24, in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al., U.S. Patent No. 6,421,716 (referred to hereafter as Eldridge).

As to claims 1, 13 and 25 respectively, Eldridge teaches a method, computer program code and a system for facilitating user interface roaming, comprising:

(a) receiving from the wireless device a list of usable interface clients in proximity to the wireless device, wherein each usable interface client has capabilities associated therewith (see col. 9 lines 13-col. 10 lines 26, a list of usable services are received at the wireless device);

(b) selecting one of the interface clients from the list (see col. 9 lines 13-col. 10 lines 26, user may select service);

(c) notifying the wireless device of the selected interface client (see col. 9 lines 13-col. 10 lines 26);

(d) initiating a connection with the selected interface client (see col. 9 lines 13-col. 10 lines 26, user may use the selected service);

(e) executing an application based on the capabilities of the selected interface client, wherein execution of the application generates content (see col. 9 lines 13-col. 10 lines 26); and

(f) transmitting the generated content to the interface client (see col. 9 lines 13-col. 10 lines 26).

As to claims 2, 14 and 26, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, further comprising receiving a notification from the wireless device that it has been is activated, wherein the wireless

device determines usable interface clients in proximity thereto upon activation thereof (see col. 9 lines 13-col. 10 lines 26).

As to claims 3, 15 and 27, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, wherein the connection with the selected interface client is initiated via the wireless device (see col. 9 lines 13-col. 10 lines 26).

As to claims 4, 16 and 28, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, wherein the generated content is transmitted to the interface client via the wireless device (see col. 9 lines 13-col. 10 lines 26).

As to claims 5, 17 and 29, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, wherein each interface client includes a display (see col. 9 lines 13-col. 10 lines 26).

As to claims 6, 18 and 30, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, further comprising receiving information from the user based on the generated content, generating subsequent content based on the received information, and transmitting the subsequently generated content to the interface client (see col. 9 lines 13-col. 10 lines 26).

As to claims 7, 19 and 31, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, further comprising:

receiving a notification that another interface client is proximate to the wireless device, querying a user whether the user would like to switch to the other interface

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client, and transmitting generated content to the other interface client upon receipt of a response from the user indicating that the user wants to switch to the other interface client (see col. 9 lines 13-col. 10 lines 26)

As to claims 8, 20 and 32, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, wherein the wireless device receives the content if the list of usable interface clients includes zero usable interface clients in proximity to the wireless device (see col. 9 lines 13-col. 10 lines 26).

As to claims 9, 21 and 33, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, further comprising: receiving information from the wireless device input by a user (see col. 9 lines 13-col. 10 lines 26).

As to claims 10, 22 and 34, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, wherein the wireless device and the interface client are capable of communicating utilizing TCP/IP or IPX protocols (see col. 9 lines 13-col. 10 lines 26).

As to claims 11, 23 and 35, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, wherein the wireless device has telephony capabilities (see col. 9 lines 13-col. 10 lines 26).

As to claims 12, 24 and 36, Eldridge teaches the method, computer program code and a system of claims 1, 13 and 25 respectively, wherein executing an application based on capabilities of the selected interface client further comprises

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uploading from a data store information relating to configuring the application based on the capabilities of the selected interface client (see col. 9 lines 13-col. 10 lines 26).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

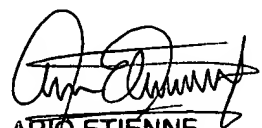
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

Nov. 25, 2005

  
ARIO ETIENNE  
PRIMARY EXAMINER